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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,278	03/04/2002	Stephen Donovan	HACK:016US	9538

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EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,278

Applicant(s)

DONOVAN, STEPHEN

Examiner

Tan Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 119-162 and 164-174 is/are pending in the application.
- 4a) Of the above claim(s) 119-156 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 157-162 and 164-174 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/05/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is the third office action for serial number 09/973,278. This application contains claims numbered 119-156, 157-162 and 164-174. Claims 1-118 and 163 have been canceled. Claims 119-156 were withdrawn. Claims 164-174 are newly added which appears to be directed to the group of invention that Applicant has been elected.
2. IDS submitted 10/05/04 has been considered.

Drawings:

3. The amendment to drawings were received on 10/05/04. However, these drawings are not accepted by examiner for the following reasons:

Drawings changes have not been made in complying with 37 CFR 1.84. Any replacement drawing sheets must be identified in the top margin as "Replacement Sheet".

Specification

4. The amendment filed 10/05/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: For example: On page 4 of the amendment, the adding of Figs 21-23 (on page 10) introduce new matter, see "Fig. 21 is a perspective view of the louvre assembly. Fig. 22 is a perspective view of a modular building unit having a side wall panel connected by a hinge to the base and/or top of the unit; and Fig. 23 is a perspective view of the modular building unit of Figure 22 with additional wall panels and glass facades". Also the adding on page 37: " Fig. 22

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shows a modular building unit 200 for use in the invention. As in Fig. 16, the unit 200 has a floor panel 202, a fixed side wall panel 204, a movable side wall panel 206 and a ceiling or roof panel 208. As shown in Fig. 22, the movable side wall panel 206 is adapted to be able to be hingedly connected to the remainder of the module at its top and hingedly connected to the floor at the base of the side wall panel 206..."

More particularly, Applicants have further added the building unit as shown on Figure 22 with "additional wall panels and glass facades" and "the unit 200 has a floor panel 202, a fixed side wall panel 204, a movable side wall panel 206 and a ceiling or roof panel 208". These introduce new matter into the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 157-162 and 164-174 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, for example, Applicant has added a floor panel, side panels and a ceiling panel wherein one of the panels is movable panels removably or hingedly connected to other panels; and at least one story of the building is arranged with a free space between the building units as recited on claims 157, 164 and 167, which were not described in the disclosure as original filed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 157-162 and 167-168 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 157 recites the limitation "the spaced" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 166 recites the limitation "the base" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 157-161, 164-169 and 171-174 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,785,095 to Verner.

Regarding claim 157, Verner discloses a multi-unit folding slab construction as typically shown in Figs. 1-2, for example) comprising floor panel, a side wall panels and a ceiling or roof panel arranged and dimensioned to form a shipping container transportable by a containerized shipping network, and wherein, at least one of the panels of the modular building unit is a movable panel removable or hingedly connected to the other panels and movable to create additional building space adjacent a space formed-by the other panels of said modular building unit.

Regarding claims 158 and 160-161, Verner also discloses at least one moveable panel is removable and can be utilizable as a structural end wall, a verandah section, a roof section or a floor section to at least partly enclose said additional building space; and wherein the at least one moveable panel is a side wall panel hingedly connected to the top of the unit so that the at least one moveable panel can swing upwardly to form an external roof of said additional building space and at least one movable panel is a side wall panel having a first hinged section that swings downwardly to form an external floor or roof.

Regarding claim 159, Verner discloses at least one moveable panel is a sidewall panel hingedly connected to the base of the unit so that the at least one moveable panel can swing downwardly to form an external floor of said additional building space.

Claims 164-169 and 171-174 recited limitations similar to those limitations recited in claims 157-161 are therefore, also disclosed by Verner.

Claims 157-162 and 164-174 are rejected under 35 U.S.C. 102(b) as being anticipated by CA Patent No. 2,174,150 to Deschamps

Regarding claim 157, Deschamps discloses a multi-unit folding slab construction (as typically shown in Figs. 1-7) comprising floor panel, a side wall panels and a ceiling or roof panel arranged and dimensioned to form a shipping container transportable by a containerized shipping network, and wherein, at least one of the panels of the modular building unit is a movable panel removably or hingedly connected to the other panels and movable to create additional building space adjacent a space formed-by the other panels of said modular building unit.

Regarding claims 158 and 160-161, Deschamps also discloses at least one moveable panel is removable and can be utilizable as a structural end wall, a verandah section, a roof section or a floor section to at least partly enclose said additional building space; and wherein the at least one moveable panel is a side wall panel hingedly connected to the top of the unit so that the at least one moveable panel can swing upwardly or downwardly to form an external roof of said additional building space.

Regarding claim 159, Deschamps discloses at least one moveable panel is a sidewall panel hingedly connected to the base of the unit so that the at least one moveable panel can swing downwardly to form an extremely floor of said additional building space.

Regarding claim 162, Deschamps also discloses or more additional wall panels and glass facades that are provided to at least partially enclose the additional building space (Fig. 5).

Claims 164-174 recited limitations similar to those limitations recited in claims 157-162 are therefore, also disclosed by Deschamps.

Response to Arguments

9. Applicant's arguments filed 10/05/04 have been fully considered but they are not persuasive.

Applicant has further amended independent claim 157 and added newly independent claim 164 and pointed to alleged differences between the prior art and his invention based upon amendment introduced into claims. However, these independent claims and along with other dependent claims still stand rejected based on Verner and Deschamps as pointed out in the office action.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1,886,962 to La Roche

Fr 2,547,332 to Philippe

The above patents disclose various types of multi-folding slabs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244.

The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent examiner
January 11, 2005



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER